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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/940,083	08/27/2001	Timothy R. Feldman	M-9793 US	6399

7590 08/26/2005

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EXAMINER

BAYAT, BRADLEY B

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 08/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/940,083

Applicant(s)

FELDMAN ET AL.

Examiner

Bradley B. Bayat

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-25 and 27-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20-25 and 27-30 is/are rejected.
- 7) ☒ Claim(s) 27 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 10, 2005 has been entered.

Status of Claims

This communication is in response to amendment filed on June 10, 2005:

- Claims 20-25 and 27-30 remain pending.
- Claims 26 and 31 are cancelled.

Response to Arguments

Applicant's arguments with respect to independent claims have been considered but are moot in view of the new ground(s) of rejection.

Specification

The disclosure is objected to because of the following informalities:

- Applicant's references to related applications at the time of disclosure did not identify them by serial/patent number since they were likely unassigned.

However, if the references are now assigned a serial/patent number, applicant is advised to submit an amended disclosure to rectify the "blanks [0002-0003]". See 37 CFR 1.78 and MPEP § 201.11.

Appropriate correction is required.

- The attempt to incorporate subject matter into this application by reference to “attorney docket numbers” [specification 0001 and 0004] is ineffective and improper. Essential material may be incorporated by reference to US patent or US patent application publications. See 37 CFR 1.57.

The incorporation by reference will not be effective until correction is made to comply with 37 CFR 1.57(b), (c), or (d). If the incorporated material is relied upon to meet any outstanding objection, rejection, or other requirement imposed by the Office, the correction must be made within any time period set by the Office for responding to the objection, rejection, or other requirement for the incorporation to be effective. Compliance will not be held in abeyance with respect to responding to the objection, rejection, or other requirement for the incorporation to be effective. In no case may the correction be made later than the close of prosecution as defined in 37 CFR 1.114(b), or abandonment of the application, whichever occurs earlier.

Any correction inserting material by amendment that was previously incorporated by reference must be accompanied by a statement that the material being inserted is the material incorporated by reference and the amendment contains no new matter. See 37 CFR 1.57(f).

Claim Objections

Claim 27 is objected to because of the following informalities: claim 27 is recited to depend on cancelled claim 26.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 20-25 and 27-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Lee et al. (hereinafter Lee), US Patent 6,636,966 B1 (filed April 3, 2000 and published October 21, 2003).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

20. A storage device, comprising:

- a storage medium (fig 1, 10); and
- a storage engine (fig 1, 14), the storage engine being configured to generate a secure session key and to receive encrypted content and a corresponding encrypted content key from a host system, wherein the content key has been

encrypted by the host system using the secure session key(column 4, lines 35-65), the storage engine being further configured to decrypt the encrypted content key using the secure session key and to encrypt the decrypted content key with a first storage engine encryption key(columns 9, lines 39-54) and to write the storage-engine-encrypted content key to the storage medium (fig 2A, 28) .

21. The storage device of claim 20, wherein the storage engine is further configured to generate the secure session key in response to verifying the authenticity of a certifying authority's digital signature provided by the host system (Table 1, verify certificate; fig 3A-C and associated text).

22. The storage device of claim 21, wherein the storage engine is further configured to encrypt the secure session key using a public key provided by the host system such that the host system can recover the secure session key only by decrypting the encrypted secure session key using the private key corresponding to the public key (Table 3, private key mechanism).

23. The storage device of claim 22, wherein the storage engine is further configured to doubly-encrypt the encrypted content using at least a second storage engine encryption key (column 11, lines 37-54).

24. The storage device of claim 23, wherein the second storage engine encryption key comprises a Data Encryption Standard (DES) key (column 11, 22-37).

Art Unit: 3621

25. The storage device of claim 24, wherein the DES key comprises a triple DES key (column 11, lines 22-37).

26. CANCELLED.

27. The storage device of claim 26, wherein the optical disc is a removable optical disc (column 6, lines 26-44).

28. The storage device of claim 22, wherein the public key and the private key are elliptic curve cryptography keys (columns 11, lines 13-column 12, line 20; see table 3; cryptographic functions).

29. The storage device of claim 20, wherein the storage engine includes a random number generator for generating the secure session key (Table 1, engine creates random key).

30. A method of writing to a storage device from a host system having a public key and a corresponding private key, comprising:

- encrypting a secure session key using the public key (fig 2b, step 225);
- recovering the secure session key from the encrypted secure session key using the corresponding private key (fig 2a, step 24);
- encrypting content according to a content key and commanding the storage device to write the encrypted content to a storage medium (fig 2a, steps 26 and 28);

Art Unit: 3621

- encrypting the content key using secure session key and transmitting the encrypted content key to the storage device (fig 2b, step 200-230) ; and
- in the storage device, decrypting the encrypted content key using the secure session key (fig 2b, steps 235-254).

31. CANCELLED.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 30 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-19 of U.S. Patent No. 6,636,966 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one of ordinary skill in the art at the time of the invention to perform the recited method steps in view of the patented method claims enabling access to a storage medium based on decrypting pieces of data acquired to further prevent unauthorized access to media.

Although the Examiner has pointed out particular references contained in the prior art(s) of record in the body of this action, the specified citations are merely representative of the teachings in the art as applied to the specific limitations within the individual claim. Since other passages and figures may apply to the claimed invention as well, it is respectfully requested that the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts, or disclosed by the examiner.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- US Patent 6,359,986 B1 to Tatebayashi.
- US Patent 6,868,494 B1 to Shitara et al.
- US Patent 6,471,068 B1 to Kido et al.
- US 6,249,866 B1 to Brundrett et al.

Art Unit: 3621

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley B. Bayat whose telephone number is 571-272-6704. The examiner can normally be reached on Tuesday - Friday 8 a.m.-6:30 p.m. and by email: bradley.bayat@uspto.gov. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached regarding urgent matters at 571-272-6712.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Or faxed to:

(571) 273-8300 - Official communications; including After Final responses.

(571) 273-6704 - Informal/Draft communications to the examiner.

A handwritten signature in black ink, appearing to read 'Bradley Bayat', with a long horizontal stroke extending to the right.

Bradley B. Bayat
Technology Center 3600
Art Unit 3621 – Patent Examiner